

Remarks

Claims 1 to 29 were pending. By this Amendment, claims 1 to 6, 9 to 14, and 19 to 24 have been amended. The phrase "an optical isomer, enantiomer, tautomer" has been deleted from the claims since such is redundant and understood to be within the scope of a claim to the compound and no change in scope is thereby made or intended. No new matter is presented by the amendments and entry is respectfully requested. Accordingly, claims 1 to 29, as amended, are now pending.

The Examiner rejected claims 1 to 17 and 26 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite.

In response, applicants maintain that the claims as amended are not indefinite and request further clarification of the basis for the Examiner's rejection.

The Examiner objected to claims 7, and 15 to 19 as under 37 C.F.R. § 1.75(c), as being in improper form.

In response, applicants respectfully traverse the Examiner's objection and note that the Examiner is apparently working from the text of the certified English language translation of U.S. provisional application Serial No. 60/228,675 (to which benefit was claimed), which was filed with the instant application. While the claims of that provisional application translation have multiple dependencies that are improper under U.S. practice, the claims of the application, which are different, do not have such multiple dependency problems. For the Examiner's convenience, applicants point out that the instant application has "Case 1/1143" in the upper left hand corner of each page thereof, while the provisional application translation does not. Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

The Examiner rejected claims 19 to 24 under 35 U.S.C. § 112, first paragraph, as allegedly not enabled for prophylaxis.

In response, applicants have amended the claims and maintain that such amendments render the Examiner's rejection moot. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection.

The Examiner further rejected claims 1 to 8, 17, 19, 21, 23, 25, and 26 as allegedly anticipated by Gennari *et al.* (Tetrahedron Letters, 30/38, 5163-6 (1989): abstract enclosed).

In response, applicants have amended claim 1 and maintain that such amendment renders the rejection of claim 1 moot. Furthermore, applicants traverse the rejection as to claims 2 to 8, 17, 19, 21, 23, 25, and 26, as they include group A outside the scope of Gennari *et al.* Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection.

The Examiner again rejected claims 1 to 29 under 35 U.S.C. § 103(a), as allegedly unpatentable over Weinhardt *et al.* (J. Med. Chem., 27/5, 616-27 (1984): abstract enclosed).

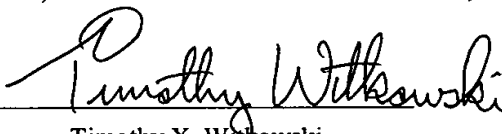
In response, applicants again respectfully traverse the Examiner's obviousness rejection and contend that the rejection is improper. A *prima facie* case of obviousness requires the satisfaction of three criteria: (i) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings; (ii) there must be a reasonable expectation of success; and (iii) the references when combined must teach or suggest all of the claim limitations. See M.P.E.P. § 2143.

Weinhardt *et al.* is directed to pharmacologically active imidazolines. The compound cited by the Examiner (CAS Ref. No. 89145-86-8) that is disclosed in Weinhardt *et al.* is used only as an intermediate for the synthesis of the pharmacologically active imidazolines that is the primary subject of Weinhardt *et al.*, as a review of the full text of Weinhardt *et al.* reveals. Thus, the whole "Results and Discussion" section in Weinhardt *et al.* (starting on page 620) is directed to imidazolines only. Thus, although Weinhardt *et al.* teaches a person of ordinary skill in the art that certain imidazolines (the final products) have pharmacological properties, Weinhardt *et al.* does not teach, suggest, or even hint that the intermediates have any pharmacological activity.

Weinhardt *et al.* accordingly fails to disclose, suggest, or hint at any pharmacological properties of the intermediates and thus there is no motivation to modify such intermediates to obtain pharmacologically active compounds or a reasonable expectation of success for such modification. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Applicants submit that all the pending claims are allowable and respectfully solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone interview would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

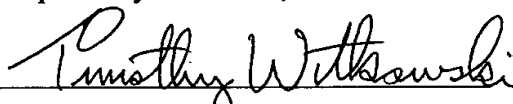
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 5, 2003.


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Dated

Respectfully submitted,


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